

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODNEY W. GIBSON

Appeal No. 1998-2692
Application 08/512,239

ON BRIEF

Before KRASS, JERRY SMITH, and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 3, 8-11 and 15-21. Claims 1, 2 and 7 have been canceled. Claims 4-6 and 12-14 have been indicated by the examiner to contain allowable subject matter. An amendment after final rejection was filed

on October 17, 1997 and was entered by the examiner.

The disclosed invention pertains to the field of transferring data between a remote controller and a user apparatus in a secure manner. The remote controller is operable in a high output power level and a low output power level. Operational commands from the remote controller are sent at the high output power level, whereas secure data from the remote controller is sent at the low output power level.

Representative claim 19 is reproduced as follows:

19. A method of transferring secure data between a remote controller and a user apparatus in a secure manner, the remote controller having means for storing the secure data, transmitting means, and means for controlling the output power of the transmitting means to have at least a low output power level and a high output power level, the user apparatus having receiving means and means to store secure data received by said receiving means, wherein the remote controller transmits operational commands for effecting operation of the user apparatus across an air interface using a communications link while said controlling means controls said transmitting means to transmit at said high output power level, characterized in that said method comprises the steps:

storing said secure data in said storing means in said remote controller;

placing the remote controller in a position closer to the user apparatus than a position used when said remote controller is transmitting said operational commands; and

transmitting said secure data across said air interface

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using said communications link from said remote controller to said user apparatus using said transmitting means at said low output power level.

The examiner relies on the following references:

Lambropoulos et al. (Lambropoulos)	4,881,148	Nov. 14, 1989
Shiota	5,572,194	Nov. 05, 1996 (filed Sep. 02, 1994)
Boyles et al. (Boyles)	5,602,535	Feb. 11, 1997 (filed July 15, 1994)

Claims 3, 8-11 and 15-21 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness the examiner offers Lambropoulos in view of Boyles with respect to claims 3, 8, 10, 11 and 16-21, and the examiner adds Shiota with respect to claims 9 and 15.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support

for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 3, 8, 19 and 21. We reach the opposite conclusion with respect to claims 9-11, 15-18 and 20. Accordingly, we affirm-in-part.

We consider first the rejection of claims 3, 8, 10, 11 and 16-21 based on the teachings of Lambropoulos and Boyles. Appellant has indicated that for purposes of this appeal these claims will stand or fall together in the following three groups: Group I has claims 3, 8, 19 and 21, Group II has claims 11 and 20, and Group III has claims 10 and 16-18 [brief, page 4]. Consistent with this indication appellant has made no separate arguments with respect to any of the

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claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against claims 19, 20 and 10 as representative of all the claims on appeal subject to this rejection.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching,

suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See, In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by

appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We first consider Group I (claims 3, 8, 19 and 21) with independent claim 19 as the representative claim. The examiner asserts that Lambropoulos teaches all the limitations of claim 19 except for the transmitting means having a low output power level and a high output power level. The examiner cites Boyles as teaching a remote control transmitter which has both a high output power level and a low output power level. The examiner then indicates why the invention of claim 19 would have been obvious within the meaning of 35 U.S.C. § 103 [answer, pages 4-6].

Appellant makes the following argument with respect to claim 19:

Boyles et al. system contemplates sending operational commands at both a standard power and a reduced power. However, Boyles et al. only discloses transmitting the secure data (i.e., the security code) from the

transmitter to the receiver at standard power (col. 7, lines 50-60). This is the opposite from that of the subject invention. In fact, there is no incentive for the Boyles et al. system to transmit the secure data at a reduced power. [brief, page 6].

We do not agree that the teachings of Boyles are as limited as argued by appellant.

Boyles teaches one embodiment in which a remote control transmitter can be adjusted to a substandard or a standard range of transmission by adjusting the output power level of the transmitter [column 7, lines 40+]. Boyles further teaches that this transmitter can be tuned down (power lowered) and the vehicle armed by standing proximate to the vehicle so that the [arming] signal does not reach the intercepting equipment of a thief [column 8, lines 5-9]. In our view, the artisan would have understood these passages of Boyles to suggest the obviousness of transmitting either secure data or operational commands at either a high output power level or a low output power level depending on the level of security desired by the user. Thus, we do not agree with appellant's argument that there is no incentive in Boyles to transmit secure data at a

reduced power level. Boyles provides essentially the same incentive as set forth in appellant's own specification. For these reasons, we sustain the rejection of claims 3, 8, 19 and 21 as set forth by the examiner.

We now consider Group II (claims 11 and 20) with claim 20 as the representative claim. The examiner's rejection indicates that Lambropoulos teaches the pseudo-random code recitations of claim 20 [answer, pages 4-5]. Appellant argues that Lambropoulos only loads a pseudo-random number into the transmitter and transfers this number to the receiver and does not teach the generation and the changing of the pseudo-random code in both the remote controller and the user apparatus as recited in claim 20 [brief, page 8].

We agree with appellant that Lambropoulos does not teach or suggest the generation and update of the pseudo-random codes in both the transmitter and the receiver as recited in claim 20. Therefore, we do not sustain the examiner's rejection of claims 11 and 20.

We now consider Group III (claims 10 and 16-18) with claim 10 as the representative claim. The examiner's rejection does not initially address the particular limitation of claim 10. Appellant argues that the claimed transmission of data from the user apparatus back to the remote controller is neither shown nor suggested by the applied prior art [brief, page 10]. The examiner responds that

this transmission and reception of data in a direction reverse to the "normal" direction, as argued, has not solved any stated problem or is for any particular purpose; therefore, the [examiner] maintains Lambropoulos et al. in view of Boyles et al.'s teaching of securely transferring data is at least fully functionally equivalent to Appellant's claimed invention [answer, page 9].

We agree with the position argued by appellant. The examiner's rejection fails to establish a prima facie case of obviousness. Functional equivalence and the solution of specific problems are not, per se, the appropriate determinants of obviousness. The examiner has failed to properly address the obviousness of the differences between the claimed invention and the applied prior art. Therefore,

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we do not sustain the examiner's rejection of claims 10 and 16-18.

We now consider the rejection of claims 9 and 15 based on the teachings of Lambropoulos, Boyles and Shiota. These claims stand or fall together [brief, page 4]. The examiner discusses this rejection on pages 6-8 of the answer. Appellant argues that the PIN of Shiota is completely different from the PIN of these claims and that the PIN in Shiota is not transmitted to other components nor stored by the other components as claimed [brief, page 9]. The examiner responds that the PIN of Shiota is alternatively equivalent to the claimed PIN [answer, page 9].

We agree with the position of appellant for the reasons noted by appellant in the brief. Therefore, we do not sustain the examiner's rejection of claims 9 and 15.

In summary, we have sustained the examiner's rejection of claims 3, 8, 19 and 21, but we have not sustained the examiner's rejection of claims 9-11, 15-18 and 20. Therefore, the decision of the examiner rejecting claims 3, 8-11 and 15-

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21 is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS)
Administrative Patent Judge)
)
) BOARD OF PATENT
JERRY SMITH)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JOSEPH L. DIXON)

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JS:pgg

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